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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/486,882	03/02/2000	DUNCAN MCGREGOR	1015-00	3081

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[REDACTED] EXAMINER

PONNALURI, PADMASHRI

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

1627

DATE MAILED: 02/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>09/486,882</b>	Applicant(s) <b>McGregor</b>
Examiner <b>Padmashri Ponnaluri</b>	Art Unit <b>1627</b>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on Dec 3, 2001.
- 2a)  This action is FINAL.      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4)  Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) \_\_\_\_\_ is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claims 1-23 are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.
- 12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some\* c) None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15)  Notice of References Cited (PTO-892)
- 16)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19)  Notice of Informal Patent Application (PTO-152)
- 20)  Other: \_\_\_\_\_

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1. This application is a 371 of PCT/GB98/02630.
2. The preliminary amendment A, filed on 3/2/00 has been fully considered and entered into the application.
3. Claims 1-23 are currently pending in this application.

**Please Note:** In an effort to enhance communication with our customers and reduce processing time, a dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Jyothsna Venkat, Ph.D., Supervisory Patent Examiner at [jyothsna.venkat@uspto.gov](mailto:jyothsna.venkat@uspto.gov) or 703-308-2439. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

***Election/Restrictions***

4. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

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Group I, claim(s) 1-10, drawn to a peptide display carrier package (PDCP).

Group II, claim(s) 11-13, 15-16, drawn to a recombinant polynucleotide comprising a nucleotide sequence encoding a chimeric protein having a nucleotide binding portion operably linked to a target peptide, wherein the polynucleotide includes a specific nucleotide sequence motif.

Group III , claim(s)14, drawn to a recombinant polynucleotide comprising a nucleotide sequence encoding a chimeric protein having a nucleotide binding portion operably linked to a target peptide, wherein the polynucleotide includes two or more nucleotide sequence motifs.

Group IV, claim(s)17-19, drawn to a genetic construct.

Group V, claim(s)20, drawn to a method of constructing a genetic library.

Group VI, claim(s)21-22, drawn to a method of screening a genetic library.

Group VII, claim(s)23, drawn to a polynucleotide comprising a nucleotide sequence.

5. The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The special technical feature or the linking feature of this invention is a recombinant polynucleotide-chimeric protein complex, which is taught by US Patent 5,498,530 (Schatz et al). The reference teach peptide libraries and methods of screening. The reference teaches that the DNA binding protein of the fusion protein (peptide fused to a DNA binding protein) bind to a specific sequence of the recombinant DNA expression vector.

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(Note: the claim is interpreted as “a peptide display carrier package comprising, a recombinant polynucleotide -chimeric protein complex, wherein the chimeric protein has a DNA binding portion and a target peptide portion.”)

6. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

- a) If group IV is elected, applicants are requested to elect a single type of vector in claim 19.
- b) If group VII is elected, applicants are requested to elect one single nucleotide sequence in claim 23.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

7. The claims are deemed to correspond to the species listed above in the following manner:  
claim 19, group IV (species election of vector); and claim 23 claim VII (species election of nucleic acid)

The following claim(s) are generic: claims 1-18, 20-22.

8. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

The different vectors in group IV, vector pDM12, pDM14, or pDM16 are structurally and functionally different from each other and do not require the other for use.

The different polynucleotide sequences with SEQ ID NO: 15, or SEQ ID NO: 17, in group VII, are structurally and functionally different from each other and do not require the other for use.

9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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10. Applicant is required to reply to this restriction requirement within 30 days of mailing this action. See MPEP 809.2(a).

Any inquiry concerning this communication should be directed to P. Ponnaluri whose telephone number is (703) 305-3884. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, can be reached at (703)308-2439. The fax number for this group is (703)305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)308-0196.

P. Ponnaluri  
Patent Examiner  
Technology center 1600  
Art Unit 1627  
14 February 2002

  
PADMASHRI PONNALURI  
PRIMARY EXAMINER